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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,489	04/06/2001	Jarmo Makela	297-006914-US (C01)	5743

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EXAMINER	
ELAHEE, MD S	
ART UNIT	PAPER NUMBER
2614	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/827,489	MAKELA ET AL.	
	Examiner	Art Unit	
	Md S. Elahee	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,12-17,20,23-26,28-30,32-34,36-38 and 40* is/are rejected.

7)☒ Claim(s) *10,11,18,19,21,22,27,31,35 and 39* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This case has been transferred from Examiner Allan Hoosain to Examiner Alam Elahee.

This application was returned to the Examiner by the Board of Patent Appeals (see paper sent on 01/12/06). Examiner Hoosain has made a new ground of rejection in Examiner's Answer mailed 05/04/2005 without TC Director's approval; thus, the Examiner's Acknowledgement to the Reply Brief mailed 09/22/05 and the Examiner's Answer mailed 05/04/2005 were vacated. Further, in light of the new ground of rejection stated in the Examiner's Answer by Examiner Hoosain, Examiner Elahee decided to reopen prosecution according to MPEP 1207.03.

Reopening of Prosecution-New ground of Rejection After Appeal

1. In view of the appeal Brief filed on 01/19/2005, PROSECUTION IS HEREBY REOPENED. The rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Allowable Subject Matter

2. Claims 10-11, 18-19, 21-22, 27, 31, 35 and 39 have already been objected in the previous office action.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U. S. 6,301,338. Because claims in the pending application are broader than the ones in patent, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application is the same

as claim 1 of the patent except that claim 1 of the pending application does not recite the types of reply messages. Therefore, claim 1 of the pending application is broader than claim 1 of the patent.

Response to Arguments

5. Applicant's arguments filed on 07/06/2005 Remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1,7-9, 12-13, 20, 23-26, 29, 30, 33, 34, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** (US 5,058,150).

As to Claims 1,20,23-25,29,33 and 37, with respect to Figures 1-2 and 5, **Mizikovsky** teaches a method for replying to a call coming to a portable terminal (mobile station 10, Fig.1) wherein, in response to the incoming call,

the portable terminal identifies the caller on the basis of caller ID [i.e., an identification information] (Col. 11, lines 8-15), or

Mizikovsky further teaches directing the incoming call to a selected accessory device such as a telephone answering machine (Col. 12, line 30) to service or answer the call (Col. 12, line 34).

Mizikovsky further teaches selecting an accessory device (i.e., telephone answering machine (hereinafter TAD)) and the device answers or service the call uniquely (such as TAD generates outgoing message (i.e., OGM) or fax machine generates CNG tone (i.e., calling tone)

when making a call and sends CED tone when responding an incoming fax call) (Col. 6, lines 51-67, Col. 7, lines 27-30). Thus, the selected device answers the call reads on claimed "reply". Also, each selected device must treat/service the call uniquely therefore, each device can produce a specific form of communication to the incoming call such as TAD generates OGM or fax machine generates CNG tone when making a call and sends CED tone when responding an incoming fax call (Col. 12, lines 25-37).

Mizikovsky further teaches the step of identifying the caller is accomplished by the portable terminal (Figure 1, label 50, Figure 2, label 114 and Figure 5, label 516).

Mizikovsky does not explicitly teach that the portable device sends the reply and provides a selected response to the caller **exclusively through the action of the portable terminal**.

In other words, **Mizikovsky** does not explicitly teach that a selected accessory device (i.e., TAD) responses are exclusively sent through the mobile terminal. Also, **Mizikovsky** does not explicitly teach that the selected device (i.e., TAD) is integrated into the mobile device.

Kang teaches that voice analyzing/synthesizing circuit (Fig.2,3, item 221) which is actually telephone answering machine, has been included and integrated into a radio telephone (Fig.2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the TAD of **Mizikovsky** into the mobile station of **Mizikovsky** so that user are not required to any external connection to connect to the external TAD to get the benefit of carrying both of the TAD along with the mobile station easily as one unit.

As to Claim 7, **Mizikovsky** teaches a method in accordance with claim 1, wherein said reply is at least partly formulated based on the identification of the calling party (Figure 5, label 506).

As to Claim 8, **Mizikovsky** teaches a method in accordance with claim 7 wherein a reply is sent to certain identified calling parties only (Figure 5, labels 508,512).

As to Claim 9, **Mizikovsky** teaches a method in accordance with claim 7, wherein the reply to be sent in response to the incoming call is different according to the respective company said call is coming from (Figure 5, labels 508,512,516).

As to Claims 12-13, **Mizikovsky** teaches a method in accordance with claim 7, wherein said identification of the calling party is based on registered caller IDs (a telephone notebook) comprised by the communication (Figure 2, label 106).

As to Claims 26,30,34,38, **Mizikovsky** teaches a portable terminal in accordance with claim 25, wherein said step of taking response action comprises sending a reply to the caller, said reply being a voice message (one of the following: a voice message, e-mail message, facsimile, and an SMS message in the form of a character string) (Col. 8, lines 51-59).

10. Claims 2, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** further in view of **Jambhekar** et al. (US 5,848,356).

As to Claims 2,6, **Mizikovsky** teaches a method in accordance with Claim 1, wherein the portable terminal sends said reply immediately in response to an incoming call, and said plurality

of forms of communication include a voice message.

Mizikovsky further teaches a facsimile peripheral which suggests a facsimile accessory and facsimile message; a multimedia terminal which suggests an e-mail accessory and response; EIA/TIA 15-54 alert messages which suggests a SMS accessory and response.

However, **Mizikovsky** in view of **Kang** does not teach, "an e-mail message, a facsimile message, and an SMS message in the form of a character string". **Jambhekar** teaches e-mail, facsimile and SMS messages (Figures 5P and 8A). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add e-mail, facsimile and SMS capabilities to **Mizikovsky's** invention in view of **Kang's** invention for providing callers with response messages as taught by **Jambhekar's** invention in order not to distract a user by sending pre-programmed responses.

11. Claims 3-5,28,32,36,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** further in view of **Bremer** (US 6,018,671).

As to Claim 3, **Mizikovsky** teaches a method in accordance with Claim 1, wherein in response to an incoming call,

Mizikovsky teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). However, **Mizikovsky** in view of **Kang** does not teach, "the portable terminal alarms and waits during a certain delay, and if a user during said delay does not answer said call, the portable terminal sends said reply". **Bremer** teaches the limitation (Figure 4, labels 4 16,420). Having the cited art at the time the invention was made, it would

have been obvious to one of ordinary skill in the art to add default capability to **Mizikovsky**'s invention in view of **Kang's** invention for providing callers with default messages as taught by Bremer's invention in order not to keep a caller waiting.

As to Claims 4,28,32,36,40, **Mizikovsky** teaches a method in accordance with claim 1, wherein in response to an incoming call, the portable terminal alarms, and:

Mizikovsky teaches providing users with alert signals and, therefore, waits for a user response (Figure 5, label 510). However, **Mizikovsky** in view of **Kang** does not teach, "if a user gives a certain key command, the portable terminal sends said reply". Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add selected message capability to **Mizikovsky's** invention in view of **Kang's** invention for providing callers with selected messages as taught by Bremer's invention in order not to keep a caller waiting.

As to Claim 5, **Mizikovsky** teaches a method in accordance with claim 3, wherein the portable terminal gives a mute soundless alarm (Col. 6, lines 43-50).

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** further in view of **Villa-Real** (US 4,481382).

As to Claim 14, **Mizikovsky** teaches a method in accordance with claim 7.

Mizikovsky teaches providing selected accessory responses to callers (Figure 5, label 518). However, **Mizikovsky** in view of **Kang** does not teach, "wherein a reminder to call the identified calling party will be stored into the portable terminal, in order to be presented to a user later". Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add reminder capability to **Mizikovsky**'s invention in view of **Kang's** invention for alerting users as taught by **Villa-Real's** invention in order to provide reminders to users when calls become due.

13. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mizikovsky** in view of **Kang** further in view of **Wolff** et al. (US 5,327,486).

As to Claims 15-17, **Mizikovsky** teaches a method in accordance claim 1, wherein said reply includes:

Mizikovsky teaches providing callers with selected user accessory responses (Figure 5, label 518). However, **Mizikovsky** in view of **Kang** does not teach, "time information". **Wolff** teaches the limitation (Figures 8-9). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add time capability to **Mizikovsky's** invention in view of **Kang's** invention for providing callers with selected time-based messages as taught by **Wolff's** invention in order not to keep a caller waiting.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Richardson et al. (US 5,459,458) teach Virtual pager for general purpose data terminal,

Anderson et al. (US 5,737,394) teach Portable telephone apparatus having a plurality of selectable functions activated by the use of dedicated and/or soft keys,

Tamir et al. (US 6,223,060) teach Voice message recorder and limited range transmitter for use with telephones,

Cogdell, Jr. (US 4,356,519) teach Portable answering device'

Marui (US 4,803,717) teach Automatic answering telephone with memory storage having storage indication and an alarm, and

Moris et al. (US 4,884,132) teach Personal security system.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ME
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January 22, 2007

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